

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

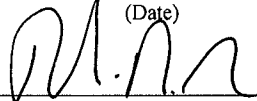
Applicant : Jorneus, et al.
App. No : 10/574,313
Filed : December 13, 2006
For : IMPLANT ARRANGEMENT WITH
AN INTERNAL SOCKET FOR A
TURNING TOOL
Examiner : Yogesh Patel
Art Unit : 3732
Conf No. : 7121

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Rabinder N. Narula, Reg. No. 53,371

PRE-APPEAL BRIEF REQUEST FOR REVIEW**Mail Stop AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully request review of the final rejection set forth in the Final Office Action dated September 26, 2008 in the above-identified application. No amendments are being filed with this request. Enclosed with this request is a Notice of Appeal.

REASONS FOR REQUEST

In the September 26, 2008 Final Office Action, Claims 1, 3-7, 10 and 12-20 stand rejected. Claims 1, 3-7, 10 and 12-16 stand rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1, 3-7, 10 and 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0177105 issued to Engman in view of U.S. Patent No. 4,681,541 issued to Snaper.

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Applicants note that Examiner has objected to Claims 18-20. Although amendments are not allowed at this time, Applicants note that the error is inadvertent and obvious, where Claims 18 and 20 should depend from Claim 17, and Claim 19 should depend from Claim 18.

In re Rejection under 35 U.S.C. § 112, ¶ 2

In the Final Office Action, Claims 1, 3-7, 10 and 12-16 stand rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action states that the phrase "the drive part comprising second lateral surfaces" is unclear. Office Action 2. Applicants respectfully point out that the "second lateral surfaces" of the drive part are the lateral surfaces that interact with the first lateral surfaces of the implant as recited in the pending claim. That is, "first" and "second" are used to distinguish two sets of "lateral surfaces" one on the dental implant and one on the turning instrument. Applicants believe that this is also clearly understood in light of the description in the specification. See Application, ¶¶ 0015, 0022. Accordingly, Applicants respectfully request that this rejection of Claims 1, 3-7, 10 and 12-16 be withdrawn.

In re Rejection under 35 U.S.C. § 103(a)

In the Final Office Action, Claims 1, 3-7, 10 and 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0177105 issued to Engman in view of U.S. Patent No. 4,681,541 issued to Snaper.

The first Office Action cited Engman as the basis for rejection of the claims under 35 U.S.C. § 102(e). In our response to the first Office Action, among other things, we asserted that Engman did not disclose the element of a friction enhancing coating. In the Final Office Action, Engman, is combined with Snaper under 35 U.S.C. 103(a), attempting to fulfill the missing element of a friction enhancing coating.

However, Snaper discloses the use of titanium nitride on a dental bur, which is essentially a drill bit used to drill holes in teeth. The Final Office Action remarks that "titanium nitride is well-known for its hardness, corrosion-resistan[ce] and biocompatib[ility]." Office Action 3.

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Examiner asserts that it would have been obvious to one of ordinary skill in the art that such a coating would allow the turning tool "to tolerate more torque." Office Action 3.

Applicant respectfully disagrees and submits that the Office Action is ignoring the radically different functions of a dental burr and a turning instrument for a dental implant. Such differences would not lead one of skill in the art to make the suggested combination.

In *KSR Int'l Co. v. Teleflex*, 127 S.Ct. 1727, 1741, the Supreme Court remarked that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." Moreover, prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. 2141.02. Here, the Office Action does not present a sufficient reason to combine the elements. On the contrary, the Office Action merely puts two references together, without considering that the function of the titanium nitride coating in Snaper on a dental burr.

In Snaper, the use of titanium nitride as a coating is so that the dental bur that is operated at high speeds would not wear down as fast, which is pertinent when drilling holes in teeth. To this effect, Snaper discloses that "nitrides are harder and more wear-resistant than carbides." Snaper, col. 3, lines 25-26. However, Snaper does not disclose anything regarding titanium nitride for the purpose of creating more friction or for purpose of enhancing torque between a turning instrument and an implant.

Thus, Snaper discloses a coating for a dental burr. The claimed invention is directed to dental implant and a turning tool for the dental implant with lateral surfaces with at least one of titanium nitride and chromium carbide coating. Yet the Office Action maintains it would be obvious for one of skill in the art to pick a coating from a dental burr, which is configured to cut and abrade bone at high speeds, and apply such a coating to the lateral surfaces between a dental implant and turning tool. Applicant submits that is unreasonable to conclude that such a combination is obvious to one of skill in the art. One of skill in the art would not recognize that a coating for a dental bone burr would improve or be suitable to a mechanical connection between a dental implant and a turning tool. The two applications are completely different and have completely different requirements.

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For example, Snaper is interested in preserving sharp edges of a bone burr as it cuts through bone at high speeds. It is unreasonable to expect one of skill in the art to apply such a coating intended to preserve sharp cutting edges on a turning tool configured to mechanically engage in implant in a relationship in which one part does not cut into another part but instead is configured to engage and transmit torque. Such hardness may indeed be harmful to the connection between two mechanical parts.

The Office Action states that the motivation for the combination is simply to provide the "well-known" properties of hardness, corrosion resistant and biocompatibility. However, as noted above, such a coating for a burr may not be suitable for mechanical parts that interact with each other.

In addition, both independent Claims 1 and 17 recite, in part, that the coating is a "friction-enhancing coating." Applicant respectfully notes that neither of the cited references disclose, teach or suggest a coating that enhances friction. Snaper, in particular, discloses a titanium nitride layer but includes no disclosure of configuring such a layer to enhance friction. Instead, Snaper discloses that such a layer increases the hardness of the burr, which suggests that the layer does not enhance friction. Thus, the recited combination also does not establish *a prima facie* case of obviousness.


CONCLUSION

In light of the remarks made above, Applicants respectfully submit that the above rejections have been overcome and that the present application is now in condition for allowance. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 12-23-08

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